

REMARKS

Claim 1 has been amended based on the disclosure at page 7, lines 22-23 in the application. Claim 9 has been amended to incorporate recitations of claim 14, and claim 14 has been canceled. Claim 10 has been amended to include recitations from original claim 9. Claims 9 and 10 have also been amended to depend from claim 1 to facilitate rejoinder on the non-elected method claims. Claim 16 has been canceled. Claim 18 has been amended so that it is a method claim. Claims 19, 20, and 21 have been added corresponding to claims 12, 13, and 15, respectively, except for depending on claims 10, 19, and 10, respectively.

Entry of the above amendment is respectfully requested.

Information Disclosure Statement

Applicants note that an Information Disclosure Statement is being submitted concurrently herewith. Applicants respectfully request that the Examiner consider the disclosed information and return an initialed PTO/SB/08 form with the next communication from the PTO.

Restriction Requirement

On page 2 of the Office Action, in paragraph 1, the Examiner sets forth the restriction requirement originally issued by telephone, in which restriction between the following groups of claims is required:

Group I, claims 1-8, 17 and 18, drawn to a porous film.

Group II, claims 9-16, drawn to a process for making a porous film.

The Examiner notes that a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8, 17 and 18, and the Examiner indicates that affirmation of this election must be made by Applicants in replying to this Office action.

In response to this restriction requirement, Applicants hereby affirm the election of Group I, claims 1-8, 17 and 18. Applicants have amended the non-elected claims to facilitate rejoinder upon allowance of the elected claims, and rejoinder in due course per MPEP 821.04(b) is respectfully requested.

Rejection under 35 U.S.C. 112, Second Paragraph

On page 3 of the Office Action, in paragraph 3, claims 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

The Examiner's Position

The Examiner's position is basically that claim 1 is in conflict with claims 3 and 8, because claim 1 makes clear that the surface of the film is porous, but claim 3 (apparently claim 2) includes a water permeability of zero and claim 8 includes a gas permeability of zero.

Applicants' Response

Applicants respectfully submit that claim 1 is not in conflict with the claims depending thereon for the following reasons:

(1) Claim 2 (believed to be the claim intended by the Examiner, since the Examiner refers to water permeability) is not in conflict with claim 1 because the recitation of a water permeability of 0 sec/ μ L in claim 2 means that 1 μ L of water takes zero seconds to permeate into the film, and thus the film is actually very porous in such a case.

(2) Similarly, the gas permeability set forth in claim 8 is not in conflict with claim 1, because a gas permeability of 0 sec/100 cc in claim 8 means that 100 cc of gas takes zero seconds to pass through the film, and thus the film is actually very porous in such a case.

In view of the above, Applicants submit that the present claims satisfy the requirements of 35 U.S.C. 112, second paragraph, and withdrawal of this rejection is respectfully requested.

Claim 18

On page 3 of the Office Action, in paragraph 4, the Examiner indicates that claim 18 provides for the use of a porous film, but since the claim does not set forth any steps involved in the method/process, it is unclear what method/process Applicants are intending to encompass. The Examiner indicates that a claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Further, claim 18 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process.

In response, Applicants have amended claim 18 so that it is a method claim setting forth an active, positive step. Accordingly, Applicants submit that the issue raised by the Examiner in this regard has been resolved, and withdrawal of the rejection under 35 U.S.C. 101 is respectfully requested.

Rejection over JP '822

On page 4 of the Office Action, in paragraph 7, claims 1-8, 17 and 18 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2002-209822.

In response, Applicants respectfully submit that the present invention patentably distinguishes over JP '822 because of the mean pore size on both of the two surfaces as recited in the present claims. Applicants submit that JP '822 is completely silent about a pore size of a surface which is contacted to a base material. In this regard, the open area of the porous film set forth in JP '822 indicates the open area of the surface which does not contact the PET film as a substrate.

Applicants submit that a porous film made by a casting method and using a coagulating bath usually has a difference between one surface and the other in their open areas. When a casting film is soaked in a coagulating bath, at first coagulating solution meets one surface which is not contacted to a base material and then slowly seeps and reaches the other side of the film which is contacted to a base material. Such a time lag causes a difference in the property of the two faces.

In order to decrease the difference between the two surfaces, especially in regard to the open area of the porous film, Applicants have first invented, and have claimed, a porous film which has less difference between both surfaces.

Applicants note that the Examiner indicates that JP '822 and the present invention use the same material and the same method, but Applicants submit that such is not correct. While the present invention and JP '822 are similar in the polymer used, Applicants submit that the films themselves in the present invention and JP '822 are significantly different due to the significant difference in the method of producing the film, for example, in the use of a coagulating bath containing at least one compound selected from a polyhydric alcohol substance and/or a C5-19 hydrocarbon as recited in amended claim 9 and in using a base material subjected to rubbing treatment as recited in amended claim 10.

Therefore, the film of the present invention and that of JP '822 are not same in their surface character, and thus the present invention is neither anticipated by nor obvious over JP '822. Accordingly, withdrawal of this rejection is respectfully requested.

Art Rejection over Ohno

On page 5 of the Office Action, in paragraph 8, claims 1-8, 17 and 18 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 01/19906.

In response, Applicants submit that Ohno is completely silent about the open area of the porous film. While the Examiner says Ohno uses the same material and the same approach to form the porous film, and his position is that the physical property would be inherently present, Applicants submit that such is not correct, because the approaches of Ohno and the present invention are not same.

In particular, Applicants submit that Ohno does not describe about using a coagulating bath containing at least one compound selected from a polyhydric alcohol substance and/or a C5-19 hydrocarbon as recited in amended claim 9, nor does it describe about using a base material subjected to rubbing treatment as recited in amended claim 10.

Further, while the Examiner says the porosity of 60% to 80% would read on the open area ratio on the film surface as well, Applicants submit that such is not correct, because porosity simply means the rate of volume of pores in the film, but does not mean any pore size.

Applicants submit that this fact is shown in the present specification at pages 27-28 in connection with Comparative Example 1, wherein the film of that comparative example had a

high porosity of 83%, but its surface open area was extremely low and was extremely non-uniform as can be seen in the SEM photograph of a cross-section of the porous film (Fig. 3).

Thus, Applicants submit that the present invention is neither anticipated by nor obvious over Ohno, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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